

REMARKS

I. General

Claims 1-55 are pending in the present application. Claims 1, 10, 32, 43-44, and 51 stand rejected under 35 U.S.C. § 102. Claims 2-9, 11-31, 33-42, 45-50, and 52-55 stand rejected under 35 U.S.C. § 103. Applicant respectfully traverses the rejections of record.

Claim 1 stands objected to as having a missing occurrence of the word “to”. Applicant has amended the claim as suggested by the Examiner. The scope of the claim remains unaltered by this amendment and no new matter has been added.

Applicant acknowledges the Examiner’s note appearing at page 18 of the Office Action, wherein it is stated that the Examiner has cited particular columns and line numbers in the references as representative of the teachings of the art. The Examiner requests that Applicant fully consider the references in their entirety as potentially teaching all or part of the claimed invention. Applicant points out, however, that it is the Examiner’s burden to establish a *prima facie* case for rejecting the claims, see *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002) (stating, “the PTO bears the initial burden of presenting a *prima facie* case of unpatentability.”). The Examiner cannot shift this burden of presenting a *prima facie* case by asking Applicant to parse through the art in a quest for any basis for rejecting the claims that the Examiner may have made. Consistent with the foregoing, the Rules require that “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable,” 37 C.F.R. § 1.104(c)(2). Accordingly, Applicant requests that the Examiner specifically identify any disclosure relied upon when rejecting the claims. Moreover, where the Examiner later relies upon different portions of the disclosure in response to Applicant’s arguments, the Examiner cannot make such a new rejection final.

II. The 35 U.S.C. § 102 Rejections

Claims 1, 10, 32, 43-44, and 51 stand rejected under 35 U.S.C. § 102(e) as being unpatentable over Kageyama et al., United States patent application publication number 2003/0097463 (hereinafter *Kageyama*), in view of Fenton et al., United States patent application publication number 2003/0193951 (hereinafter *Fenton*). Because the rejection of

record relies upon modification of *Kageyama* in view of *Fenton*, Applicant believes that the rejection under 35 U.S.C. § 102 was intended to be a rejection under 35 U.S.C. § 103.

Therefore, the rejection of these claims will be addressed in the section below dealing with 35 U.S.C. § 103 rejections. If the foregoing is not correct, Applicant requests clarification of the 35 U.S.C. § 102 rejection.

III. The 35 U.S.C. § 103 Rejections

Claims 1, 10, 32, 43-44, and 51 stand rejected under 35 U.S.C. § 102(e) [sic: 103(a)?] as being unpatentable over *Kageyama* in view of *Fenton*. Claims 2-5 and 7-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kageyama* in view of *Fenton* and further in view of Babu et al, United States patent number 7,139,252 (hereinafter "*Babu*"). Claims 11-21, 24-29, 31, 33-42, 45-50, and 52-55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kageyama* in view of *Fenton* further in view of Konito et al., United States patent application publication number 2004/0249768 (hereinafter "*Konito*"). Claims 6, 22, 23, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kageyama* in view of *Fenton* further in view of *Konito* and still further in view of Lewis, United States patent application publication number 2005/0256937 (hereinafter *Lewis*).

To render a claim unpatentable under 35 U.S.C. § 103, all the claim limitations must be taught by the prior art, M.P.E.P. § 2143.03. Moreover, the Examiner must provide analysis supporting any rationale why a person skilled in the art would combine the prior art to arrive at the claimed invention, and "[such] analysis should be made explicit," *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007). The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness, M.P.E.P. § 2142; *In re Peehs*, 204 U.S.P.Q. 835, 837 (CCPA 1980). As the applied art does not meet all the claim limitations and the Examiner has not provided proper analysis supporting rationale why a person skilled in the art would have combined the applied art to arrive at the claimed invention, a *prima facie* case of obviousness has not been established with respect to the present claims.

A. Claims 1-9

Claim 1 recites "performing media negotiations with a system associated with said second user device to inform a media delivery system of attributes of said second user device

. . . .” The rejection of record relies upon *Kageyama* teaching a system at paragraph 0025 providing negotiation between two different devices through a transmitting source to meet this aspect of the claim, Office Action at page 3. However, the identified portion of *Kageyama* merely discloses “[a] device . . . provided with a receive condition management part that sets and manages receive conditions for receive attribute information from the disclosure source, and a second negotiation part that forms an agreement on conditions for disclosing the attribute information,” paragraph 0025. Accordingly, the identified portion of *Kageyama* neither discloses performing media negotiations nor performing negotiations to inform a media delivery system of attributes of a second user device, and thus does not meet the claim.

Moreover, the disclosure of *Kageyama* in general is insufficient to meet the claim. For example, the attribute information of *Kageyama* is not attributes of the second user device as expressly required by the claim. Instead, *Kageyama* teaches the attribute information therein being user-identifying profile information (containing an address, name, sex, birth date, and the like) and preference information (containing hobbies, preferences, favorite contents genres, favorite agencies, and favorite users), see paragraph 0060. The foregoing attribute information simply is not, and cannot be read to be, attributes of the second user device as required by the claim.

The foregoing distinction becomes even more clear when the claim is read as a whole, as required by M.P.E.P. § 2141, see also *Graham v. John Deere and Co.*, 383 U.S. 1 (1966). Of particular note, in addition to the attribute information in *Kageyama* not being user device attribute information, the attribute information of *Kageyama* is associated with the first system therein. That is, the system of *Kageyama* which provides data to be delivered is the same system with which the attribute information is associated, see e.g., paragraph 0098. However, claim 1 requires “accepting information from a first user device with respect to content to be delivered to a second user device [and] performing media negotiation with a system associated with said second user device to inform a media delivery system of attributes of said second user device.” (emphasis added). Clearly, the disclosure of *Kageyama* does not meet the claim.

Claim 1 further recites “configuring, by said media delivery system, said content for delivery to said second user device as a function of said attributes of said second user device.” The rejection of record relies upon disclosure of *Kageyama* at paragraph 0025 teaching that attributes are exchanged with respect to first and second devices for configuring data transmitting, Office Action at page 3. However, neither the identified portion of *Kageyama* nor any portion of *Kageyama* reviewed by Applicant teaches use of the attribute information relied upon in the rejection to configure content for delivery to a second user device as a function of attributes of the second user device. It is nonsensical to suggest that user-identifying profile information and preference information negotiated from a first system (relied upon by the Examiner as the claimed attribute information) are either attributes of a second system or used to configure content for delivery to a second system. If the Examiner maintains the rejection based upon an assertion that *Kageyama* discloses configuring content for delivery to a second user device as a function of attributes of the second user device, Applicant respectfully requests that the Examiner point out with specificity where the disclosure of *Kageyama* teaches the foregoing in order that Applicant may be given a full and fair opportunity to reply as required under M.P.E.P. § 706.02(j).

The rejection of record concedes that *Kageyama* does not disclose “MMS or Multimedia message server,” presumably in response to the language of claim 1 reciting “a media delivery system.” The rejection of record thus introduces *Fenton* to teach “MMS or Multimedia message server connected to different wired and wireless network performing as gateway,” Office Action at page 3. In opining that the proffered combination would have been obvious, the Examiner asserts that “it would have been obvious to one ordinary skilled in the art at the time the invention was made to combine the teachings of *Kageyama* with the teachings of *Fenton* in order to provide a system that forms an agreement by negotiation with a center device and terminals capable of negotiation, and computer programs for achieving their functions, and enables negotiation about the particularly attribute information and contents,” *id.* Even assuming, *arguendo*, that the Examiner’s assertion were accurate, no reason has been set forth as to why one of ordinary skill in the art would have found it obvious to modify *Kageyama* to include a “MMS or Multimedia message server.” That is, the Examiner merely asserts that after modification of *Kageyama* in view of *Fenton*, *Kageyama* would operate exactly as the Examiner asserts *Kageyama* already operates.

There is nothing in the foregoing to support a person skilled in the art combining a “MMS or Multimedia message server” into the system of *Kageyama*. The Examiner must provide analysis supporting any rationale why a person skilled in the art would combine the prior art to arrive at the claimed invention, and “[such] analysis should be made explicit,” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007). Accordingly, the rejection of record is improper.

A further flaw in the proffered modification of *Kageyama*, is the fact that claim 1 requires a media delivery system configuring the content for delivery to the second user device as a function of the attributes of the second user device. *Kageyama* provides a fundamentally different system, in which user-identifying profile information (containing an address, name, sex, birth date, and the like) and preference information (containing hobbies, preferences, favorite contents genres, favorite agencies, and favorite users) is provided from a first system to a second system upon appropriate negotiation. Merely adding a media delivery system of *Kageyama*, in addition to being borne out of impermissible hindsight, does nothing to cause the user-identifying profile information and preference information to be configured for delivery to a second system as a function of attributes of the second system.

As shown above, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with respect to claim 1. Accordingly, claim 1 and the claims dependent therefrom are asserted to be patentable over the art of record.

B. Claims 10-42

The United States Supreme Court in *Graham v. John Deere and Co.*, 383 U.S. 1 (1966) set forth the factual inquiries which must be considered in applying the statutory test for obviousness under 35 U.S.C. § 103 as: (1) determining of the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art. “Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case,” M.P.E.P. § 2141 (emphasis original). Accordingly, when making a rejection under 35 U.S.C. § 103(a), M.P.E.P. § 706.02(j) directs the Examiner to set forth in the Office action: (1) the relevant teachings of the prior art relied upon; (2) the difference or differences in the claim over the applied

references; (3) the proposed modification of the applied references necessary to arrive at the claimed subject matter; and (4) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. M.P.E.P. § 706.02(j) further points out that “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.”

Although claims 10 and 32 are indicated as being obvious under 35 U.S.C. § 103 over *Kageyama* in view of *Fenton*, the rejection of record fails to identify any differences between the applied art and the claims at issue. Likewise, the rejection of record neither proffers a proposed modification of the applied references to arrive at the claimed subject matter nor provides any reasoning as to why one of ordinary skill in the art would have been led to the claimed invention from the disclosure of the applied art or the prior art in general, see *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007). Accordingly, the Examiner has failed to satisfy the initial burden of establishing a proper rejection in accordance with the directives of the M.P.E.P. and as required under *Graham*.

Claim 10 recites “said stored content being uniquely identified” Similarly, claim 32 recites “uniquely identifying said stored content” The rejection of record merely concludes “obviously database contains an identifier for each entry which could be unique identifier for each content, record, item etc.,” Office Action at page 3. However, a conclusion as to obviousness is insufficient to establish a *prima facie* case of obviousness, see Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Vo. V. Teleflex Inc.*, 72 Fed. Reg. 57526, 57528 (Oct. 10, 2007).

Moreover, an assertion that an identifier for each entry could be a unique identifier is not sufficient to meet the claim. There is nothing in the art or otherwise made of record to show that an identifier for each entry is a unique identifier. The express language of the claims cannot be rejected based upon possibilities and probabilities, see e.g., *In re Robertson*, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999).

Claim 10 recites “said server adapted to receive from a first user device . . . a message including identification of certain content of said stored content for sending at least a portion

of said stored content to a second user device . . . as a multi-media message.” Similarly, claim 32 recites “receiving, at said server, from a first user device . . . an abbreviated message including identification of certain content of said stored content for sending . . . to a second user device . . . as a data rich message” The rejection of record relies upon Figure 1 and paragraph 0041 of *Fenton* to meet the foregoing. Specifically, elements 102, 104, 106, 108, etc. of Figure 1 and lines 2-4 of paragraph 0041 are relied upon as teaching user devices and elements 130, 132, and 134 and lines 5-30 of paragraph 0041 are relied upon as teaching a message and content is assigned an identification along with multimedia type, delivery options, time stamp, etc., Office Action at page 4. The foregoing, however, does not meet the claims.

The identified portion of *Fenton* teaches that a multimedia message is submitted to the originator MMS relay by the user agents and that, if the delivery is to be delayed, the originator MMS will provide a message identification to the user agent, paragraph 0041, lines 22-27. Clearly, *Fenton* does not operate such that a server receives identification of stored content from a first user device for sending the stored content to a second user device. Consistent with Applicant’s position, *Fenton* generally teaches a system in which multimedia messages transmitted by a user agent are to receive customized processing or standard processing, see e.g., paragraph 0008.

As shown above, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with respect to claims 10 and 32. Accordingly, claims 10 and 32, and the claims dependent therefrom, are asserted to be patentable over the art of record.

C. Claims 43-50

As with claims 10 and 32 discussed above, although claim 43 is indicated as being obvious under 35 U.S.C. § 103 over *Kageyama* in view of *Fenton*, the rejection of record does not identify any differences between the applied art and the claims at issue, does not proffer a proposed modification of the applied references to arrive at the claimed subject matter, and does not provides any reasoning as to why one of ordinary skill in the art would have been led to the claimed invention from the disclosure of the applied art or the prior art in general, see *Graham*, 383 U.S. 1, see also *KSR Int’l Co.* 550 U.S.____. Accordingly, the

Examiner has failed to satisfy the initial burden of establishing a proper rejection in accordance with the directives of the M.P.E.P. and as required under *Graham*.

Claim 43 recites “said stored content being uniquely identified” The rejection of record relies upon Figure 1 and paragraph 0041, lines 22-31, of *Fenton* to meet the foregoing. However, the identified portion of *Fenton* teaches that “[u]pon reception of a multimedia message from an originator MMS User Agent 102, 104, 106, 108, 110 and 112, the originator MMSE: will assign a Message Identification to the multimedia message and provide the originator MMS User Agent 102, 104, 106, 108, 110 and 112 with this Message Identification” There is nothing in this disclosure, nor can Applicant find any disclosure in *Fenton*, to teach content stored in a gateway database being uniquely identified. For example, there is nothing to show that the Message Identification uniquely identifies stored content.

Claim 43 further recites “distribution control apparatus for receiving from at least one of said users a unique identification of certain content of said stored content and for sending at least a portion of said uniquely identified content to a recipient identified by said one user.” The rejection of record relies upon element 126 of Figure 1 and paragraph 0028 of *Fenton* to teach an MMS server acts as a message distributor where the message is personalized, filtered, screened, formatted, deleted based on user profile, Office Action at page 4. The foregoing, however, does not meet the claims. *Fenton* generally teaches a system in which multimedia messages transmitted by a user agent are to receive customized processing or standard processing, see e.g., paragraph 0008. Accordingly, the identified portion of *Fenton* teaches receiving and sending multimedia messages, but does not teach receiving a unique identification of stored content for sending the uniquely identified content to a recipient identified by a user.

As shown above, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with respect to claim 43. Accordingly, claim 43 and the claims dependent therefrom are asserted to be patentable over the art of record.

D. Claims 51-55

As with claims 10, 32, and 43 discussed above, although claim 51 is indicated as being obvious under 35 U.S.C. § 103 over *Kageyama* in view of *Fenton*, the rejection of record does not identify any differences between the applied art and the claims at issue, does not proffer a proposed modification of the applied references to arrive at the claimed subject matter, and does not provides any reasoning as to why one of ordinary skill in the art would have been led to the claimed invention from the disclosure of the applied art or the prior art in general, see *Graham*, 383 U.S. 1, see also *KSR Int'l Co.* 550 U.S. _____. Accordingly, the Examiner has failed to satisfy the initial burden of establishing a proper rejection in accordance with the directives of the M.P.E.P. and as required under *Graham*.

Claim 51 recites “identifying at least a portion of multi-media content to a user” The rejection of record relies upon paragraph 0066, lines 13-16, of *Fenton* as teaching identification of multimedia content type. The foregoing, however, does not meet the claim. Specifically, identifying multimedia content type does not meet the claim language requiring identifying at least a portion of multi-media content to a user.

Claim 51 further recites “sending a message to a host remote from said user, said message containing said unique identification as well as the identity of at least one proposed recipient of said MMS message [and] upon receipt by said host of said message from said user, delivering said MMS message including multi-media content associated with said unique identification to said at least one proposed recipient.” The rejection of record relies upon Figure 1 and paragraph 41, lines 22-31, of *Fenton* as meeting the forgoing aspect of the claim, Office Action at page 5. The foregoing, however, does not meet the claim.

The identified portion of *Fenton* teaches that a multimedia message is submitted to the originator MMS relay by the user agents and that, if the delivery is to be delayed, the originator MMS will provide a message identification to the user agent, paragraph 0041, lines 22-27. Clearly, *Fenton* does not operate such that a host remote receives a message including unique identification of multi-media content and the identity of a proposed recipient for delivering the multi-media content to the proposed recipient. Consistent with Applicant’s position, *Fenton* generally teaches a system in which multimedia messages transmitted by a

user agent are to receive customized processing or standard processing, see e.g., paragraph 0008.

As shown above, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with respect to claim 51. Accordingly, claim 51 and the claims dependent therefrom are asserted to be patentable over the art of record.

IV. Summary

In view of the above, Applicant believes the pending application is in condition for allowance. Accordingly, Applicant requests that the claims be passed to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 64032/P006US/10303189 from which the undersigned is authorized to draw.

Dated: December 21, 2007

Respectfully submitted,

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